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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,563	02/17/2004	Kim Annon Ryal	020699-100600US	9282

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EXAMINER

HUBER, PAUL W

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,563	RYAL, KIM ANNON	
	Examiner	Art Unit	
	Paul Huber	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>021704</u> . | 6) <input type="checkbox"/> Other: ____. |

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-8, 12-14, 16, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Edenson et al. (USP-6,198,875).

Regarding claims 1, 3-8, 12, 17 & 19, Edenson et al. discloses a TIRIS based BIOS for protection of copywrited program information. "TIRIS cipher is a flat batteryless radio-frequency semiconductor transponder package which is bonded or embedded to the center of a copyrighted DVD media. Encrypted with a variety of encoded and/or scrambled information bits that can only be read with a TIRIS transceiver, located in the player, the disk is checked for authenticity" (col. 3, lines 3-9). "Even before the reading of the disk, the interrogator within the disk reader is interrogating the transponder located on the disk and the transponder is transmitting back to the interrogator the transponder response data stream comprising the Code Word, address of the data-word, media type information, decryption algorithm and copyright information etc. or in other words the BIOS or set-up information for the Conditional Access Management processor (CAMP)" (col. 4, lines 44-52). "...[T]he transponder could have ... read/write capability, with single or multiple page bit capacity with the cost constraints and/or system requirements actually defining those parameters" (col. 7, liners 34-37). "...[T]he last 64 bits [of the transponder response data stream]... could be reserved to contain post-manufactured rewritable data, such as the run/elapsed viewing; time counter to count the number of times the media has been played or used, i.e., to enable pay-per-view pricing, or limit the number of authorized runs for a run-specific pricing, and also store the number of 'write' cycles" (col. 5, lines 56-63). "Within the context of the BIOS, the copyright holders would define many operating parameters such as the type of media to be performed upon, how many copies, if any, are allowed, at what point in time the media is enabled, i.e. to handle regional releases etc." (col. 3, lines 23-27). "[O]utput port disabling and or interface reconfiguration may be employed upon detection of either counterfeit media, or time/use count expired media or media intended for controlled or limited distribution (time or usage based)" (col. 5, lines 26-29).

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Regarding claims 13, 14 & 16, Edenson et al. further discloses that the "bits [of the transponder response data stream] will be allocated to store at least a unique ID/serial #, a code word, media type, decryption algorithm, copyright information, and an 'encoded or encrypted' address location within the media itself etc. This disk address serves as a pointer to a specific data word which is embedded anywhere within the disk's program material. This unique data word contained on the disk within the digital data stream ... is then compared with a preassigned code word located in the memory of the transponder itself. If ... there is a match between the media data word and the code word, then authentication is complete, affording play access to the content" (col. 3, lines 48-65). Accordingly, Edenson et al. discloses: detecting a first RFID tag value (code word stored in transponder); detecting correlating information on the medium (media data word stored in disk's program material); and comparing the first RFID tag value to the detected correlating information as claimed. If correlation is determined, play access to the content of the disk is enabled and then a second RFID tag value (copyright information as explained above) can be detected in order to authorize a copy of the medium as claimed. The detected second RFID tag value is encrypted (see col. 3, lines 6-9).

Regarding claim 20, the authorization process of the copyright holder (initial pre-programming of the BIOS stored in the transponder located on the disk), performs such pre-programming remotely from the player (fig. 1 & 2) and hence the RFID read/write unit located therein. Accordingly, the authorization process is considered remotely located from the RFID read/write unit as claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edenson et al., as applied to claim 1 above, in further view of Kulnits (USP-6,005,940).

Edenson et al. discloses the invention as claimed, but fails to specifically disclose that the medium, by which the read/write RFID tag (TIRIS transponder) is attached, includes a CDROM disc. However, Edenson et al. teaches that "for the purpose of simplicity, the discussion here is limited to DVD type material only, however, the scope of the invention herein is much broader, which may include other packaged media types with associated players/appliances" (col. 7, lines 30-34). Kulnits discloses "an optical disk carrier (ODC) 1 which may be a DVD,

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audio CD or CD-ROM ... [which] includes a transponder 2 fixed to the disk carrier 1" (col. 2, line 65, through col. 3, line 1), in the same field of endeavor, for the purpose of "discouraging both home copying and commercial piracy of the underlying program material" stored on the disk carrier (abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Edenson et al. such that the read/write RFID tag (TIRIS transponder) is attached to medium other than a DVD, as suggested by Edenson et al., such as a CDROM disc as taught by Kulinets. A practitioner in the art would have been motivated to do this for the purpose of copy protecting the material stored on a CDROM, e.g., computer program data, in accordance with the invention taught by Edenson et al..

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edenson et al., as applied to claim 8 above, in further view of Official Notice.

Edenson et al. discloses the invention as claimed, but fails to specifically disclose that the access rights to the medium are enforced either in accordance with a Copy Control Information (CCI) standard, in accordance with an Extended Copy Control Information (ExCCI) standard, or in accordance with Copy Generation Management System (CGMS). However, it is manifestly well known in the art that access rights to a medium can be enforced either in accordance with a Copy Control Information (CCI) standard, in accordance with an Extended Copy Control Information (ExCCI) standard, or in accordance with Copy Generation Management System (CGMS), in the same field of endeavor, for the purpose of copy protecting the access rights to the medium in accordance with industry wide established copy protection standards or systems, and Official Notice is hereby taken of the same.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Edenson et al. such that the access rights to the medium are enforced either in accordance with a Copy Control Information (CCI) standard, in accordance with an Extended Copy Control Information (ExCCI) standard, or in accordance with Copy Generation Management System (CGMS), as is manifestly well known in the art. A practitioner in the art would have been motivated to do this for the purpose of copy protecting the access rights to the medium in accordance with industry wide established copy protection standards or systems, thereby ensuring reliable copy protection of the medium.

Relative to the doctrine of Official Notice, see *In re Fox*, 176 U.S.P.Q. 340 at 341 (CCPA 1973).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edenson et al., as applied to claim 13 above, in further view of Sako et al. (USP-6,801,490).

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Edenson et al. discloses the invention as claimed, but fails to specifically teach that the correlating information (media data word stored in disk's program material) includes a digital watermark. Sako et al. discloses embedding copy control information as watermark information into the digital copyrighted works, in the same field of endeavor, for the purpose of ensuring that the "copy control information, key, and the like are not lost even if a process such as a data compression or the like is performed" (see col. 12, lines 50-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Edenson et al. such that the correlating information (media data word stored in disk's program material) includes a digital watermark as taught by Sako et al. A practitioner in the art would have been motivated to do this for the purpose of ensuring that the correlating information (media data word stored in disk's program material) is not lost even if a process such as a data compression or the like is performed.

Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brady et al. (USP-6,201,474).

Regarding claim 17, Brady et al. discloses an apparatus for authorizing a copy of a medium 100, in reference to figures 12 & 13, wherein the medium includes an RFID tag 130. An RFID read/write unit 402 reads the RFID tag 130 and updates the value stored in the RFID tag 130. "[T]he RFID transponder 130 may be preprogrammed with a code which would disable playback of the media 100 when placed by a VCR (audio cassette player, computer tape drive, etc.). The interrogator 402 may, at the time of sale, erase this code from the RFID transponder 130 so that the customer may play the media 100 after purchase or rental" (col. 11, lines 20-28). The VCR used by the customer is considered the claimed "media read/write unit". Moreover, a control system (inherent part of RFID system 400 and integral part of transponder 130) accepts a signal from the RFID read/write unit 402 to indicate that a copy can be made.


Regarding claim 18, the VCR used by the consumer includes a housing containing the media read/write unit for the VCR tape medium 100. The RFID read/write unit 402 is external to the housing as claimed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nerlikar et al. and Tagawa et al. each disclose a copy protection system.

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.



Paul Huber
Primary Examiner
Art Unit 2653

pwh
July 2, 2005